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OFFICE OF PETITIONS

In re Patent No. 7,507,872 :
Akira et al. : DECISION ON
Application No. 10/088,567 : REQUEST FOR
Issue Date: March 24, 2009 : RECONSIDERATION OF
Filed: March 19, 2002 : PATENT TERM ADJUSTMENT
Attorney Docket No. : UNDER 37 CFR 1.705
14119.105010 :

This is in response to the REQUEST FOR RECONSIDERATION OF USPTO DECISION REGARDING CORRECTION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705, filed April 14, 2009. Patentee requests that the determination of patent term adjustment be corrected from 1067 days to 1680 days.

The request for reconsideration of patent term adjustment is **GRANTED TO THE EXTENT INDICATED.**

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of one thousand eight (1008) days.

Patentees are given THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer, from the mail date of this decision to respond to this decision. No extensions of time will be granted under § 1.136.

BACKGROUND

On March 24, 2009, the application matured into U.S. Patent No. 7,507,872, with a revised patent term adjustment of 1067 days. The Office determined that the 1193 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) overlaps with the 1134 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1) accorded prior to the filing of the request for continued examination. As such, the Office allowed only entry of an adjustment of 59 days. An additional 35 days were accorded pursuant to 37 CFR 1.702(a)(4) for issuance of the patent four months and 35 days after payment of the issue fee. Given the applicant delay of 161 days, the patent issued with a revised patent term adjustment of 1067 (1134 + 35 + 59 - 161) days.

On April 14, 2009, patentees timely submitted this request for reconsideration of patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 1680 days under the court's interpretation of the overlap provision as set forth in *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees maintain that the total non-overlapping PTO delay under §154(b)(1)(A) & (B) is 1841 (1169 + 1136 - 464 overlap) days as these periods do not occur on the same day. Further, given the applicant delay of 161 days, patentees assert entitlement to 1680 (1841 - 161) days of patent term adjustment.

OPINION

Preliminarily, it is noted that 37 CFR 1.703(b)(1) and (4) state that the period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(f) in an international application and ending on the date a patent was issued, but not including application was filed under 35 U.S.C. 111(a) and ending on the date a patent was issued, but not including (a) the number of days, if any, in the period beginning on the date on which a request for continued examination of the application was filed, and (b) in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending

on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

On June 24, 2008, a request for continued examination (RCE) was filed. The filing of an RCE cuts off the ability to accumulate any additional patent term adjustment under the three-year pendency provision. The period beginning on the day the RCE is filed to the issue date of the patent is excluded from the period under § 1.702(b). As such, the period in this instance is 1192 (not 1193) days, counting the number of days in the period beginning on March 20, 2002, and ending on June 23, 2008.

On March 12, 2008, a notice of appeal was filed. On May 8, 2008, a notice of allowance was mailed. The period beginning on March 12, 2008 and ending on May 8, 2008, is 58 days. Accordingly, a 58 day period should have been excluded from the period of adjustment under 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b). The period of adjustment under 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) should be 1134 days (1192 - 58).

Regardless, patentees' interpretation of the period of overlap has been considered, but found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C.

154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application (or, in an international application, the date that the national stage commenced under 35 U.S.C. 371(f)), is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of

adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the date the national stage commenced under 35 U.S.C. 371(f), March 19, 2002, and ending on the date of filing of a request for continued examination (RCE), June 24, 2008 (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)). The relevant period ends with the filing of the RCE as the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) does not include the period subsequent to the filing of the RCE. 35 U.S.C. 154(b)(1)(B)(i).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), 1134 days of patent term adjustment were accorded during the pendency of the application for Office delay prior to the filing of the request for continued examination. An additional 35 days of patent term adjustment were accorded pursuant to § 1.702(a)(4) for the issuance of the patent four months and 35 days after payment of the issue fee. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 1134 days of patent term adjustment accrued for Office issuance of the patent more than 3 years after the commencement of the national stage under 35 U.S.C. 371(f).

The 1134 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 1134 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both periods is neither permitted nor warranted. Considering the 35 days of Office delay under § 1.702(a)(4), 1169 (1134 + 35) days is the actual number of days issuance of the patent was delayed.

Accordingly, at issuance, the Office should have entered no additional days of patent term adjustment for the Office taking in excess of three years to issue the patent.

Further, patentee is correct that the Office failed to exclude the period of 58 days. Moreover, considering the RCE, absent the excluded 58 days, the Office incorrectly calculated 1193 days, instead of 1192, pursuant to § 1.702(b). This additional one (1) day must be removed. In view thereof, the 59 (58 + 1) days entered at issuance is being removed.

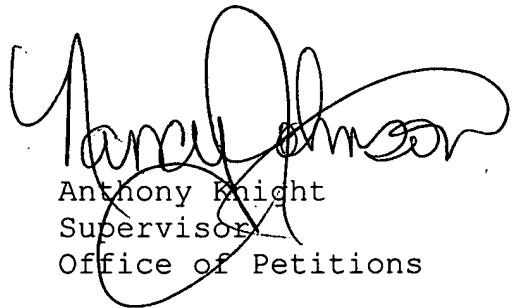
CONCLUSION

Considering the applicant delay of 161 days, the patent term adjustment at issuance is revised to 1008 (1134 + 35 - 161) days.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a Certificate of Correction indicating that the term of the above-identified patent is extended or adjusted by one thousand eight (1008) days.

As the prior decision was held in abeyance with respect to the period under 37 CFR 1.703(b) no further fee is required.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood, at (571) 272-3231.



Marcel Johnson

Anthony Knight
Supervisor
Office of Petitions

Encl: DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,507,872 B2

DATED : Mar. 24, 2009

INVENTOR(S) : Akira et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (1067) days

Delete the phrase "by 1067 days" and insert – by 1008 days--